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OFFICE OF PETITIONS

In re Patent No. 7,536,346 :
ALIFFI et al. : DECISION DISMISSING
Issue Date: May 19, 2009 : REQUEST FOR
Application No. 10/021,468 : RECONSIDERATION
Filed: October 29, 2001 : OF PATENT TERM ADJUSTMENT
Atty. Docket No. E0019/258247 : UNDER 37 CFR 1.705

This is in response to the "RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION" filed June 25, 2009, which is properly treated under 37 CFR 1.705(d). Patentees request that the determination of patent term adjustment be corrected from seven hundred ninety-five (795) days to one thousand six hundred thirty-three (1,633) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. 154(b) of 795 days.

BACKGROUND

This application was filed on October 29, 2001. On January 4, 2007, applicants filed the first request for continued examination (RCE) in the application. On October 30, 2008, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application, stating that patent term adjustment to date was 795 days.¹ On May 19, 2009,

¹ 893 days of Office delay was reduced by 98 days of applicant delay for a patent term adjustment of 795 days. Applicants did not file a request for reconsideration of this initial determination seeking reinstatement of any part of the term reduced pursuant to 37 CFR 1.704(a).

the application matured into U.S. Patent No. 7,536,346, with a revised patent term adjustment of 795 days.

On June 25, 2009, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d). Patentees contend:

The determination of the total PTA of 795 days is erroneous because the United States Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 876 days for PTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) that is set forth on the enclosed PTA History (Exhibit A) is correct, however, it only accounts for one of the delays of the PTO. The other delay warrants an additional PTA credit of 797 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1673 days (i. e., 876 days + 797 days) is appropriate based upon the PTO delay. The total number of PTA debits of 40 days for applicant delay that is set forth on the enclosed PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 1633 days (i.e., 1673 days - 40 days).

Thus, Applicants believe that the total PTA credit for PTO delay is 1673 days, the total PTA debit for applicant delay is 40 days, and the total PTA under § 1.703(f) is 1633 days.

Renewed Request dated 06/25/09, p. 2.

The Office agrees that as of the filing of the first RCE on January 4, 2007, the application was pending 3 years and 797 days after its filing date. However, the Office notes that 876 days² of patent term adjustment were accorded prior to the filing

² A nonfinal Office action was mailed on May 23, 2005, 14 months and 876 days after the application was filed on October 29, 2001.

of the RCE pursuant to 37 CFR 1.702(a)(1),³ and 17 days⁴ of Office delay occurred after the filing of the RCE pursuant to 37 CFR 1.702(a)(2).⁵ Lastly, the Office disagrees with patentees' calculation of applicant delay as 40 days. Patentees were properly assessed a period of delay of 58 days, pursuant to 37 CFR 1.704(b), for failing to file a reply to the final Office action of March 18, 2008, until August 15, 2008, three months and 58 days later. Accordingly, the total period of applicant delay is 98 (10 + 30 + 58) days.

OPINION

Patentees' interpretation of the period of overlap has been considered, but has been found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A).

³ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

⁴ The Office mailed a final Office action on March 18, 2008, 4 months and 17 days after the filing of the reply on November 1, 2007.

⁵ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*⁶ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final*

⁶ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

Rule, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

It is noted, however, that delays resulting in the Office's failure to meet the time frames specified in 35 U.S.C. 154(b)(1)(A) (the "fourteen-four-four-four" provisions) are not always overlapping with a delay resulting in the Office's failure to issue a patent within the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) because not all application pendency time is counted toward this three-year period. See 35 U.S.C. 154(b)(1)(B)(i)-(iii).

In this instance, all application pendency time is not counted toward the three-year period. The first RCE was filed on January 4, 2007. The period subsequent to the filing of the RCE is not included in the three-year time frame specified in 35 U.S.C. 154(b)(1)(B). See 35 U.S.C. 154(b)(1)(B)(i). Thus, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period from the filing of the application on October 29, 2001, to the filing of the first RCE on January 4, 2007. Thus, only the 876 days of patent term adjustment accorded prior to

the filing of the first RCE pursuant to 37 CFR 1.702(a)(1) are considered in determining overlap. The 17 days for Office delay under 37 CFR 1.702(a)(4), occurring after the filing of the first RCE is not considered. The 797 days attributed to Office delay pursuant to 37 CFR 1.702(b) for failure to issue the patent within three years after the filing of the application is determined to overlap with the 876 days attributed to Office delay pursuant to 37 CFR 1.702(a)(1). 893 (876 + 17) days is the actual number of days issuance of the patent was delayed. Accordingly, at issuance, the Office properly entered no additional period of adjustment, having considered the 797 days of Office delay under the three-year pendency provision.

CONCLUSION

In view thereof, the Office affirms the revised determination of patent term adjustment at the time of the issuance of the patent is 795 days ((893 (876 + 17) days of Office delay - 98 (10 + 30 + 58) days of applicant delay)).

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e) on January 30, 2009. No additional fees are required.

Telephone inquiries specific to this matter should be directed the undersigned at (571) 272-3211.

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